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FOLEY & LARDNER LLP
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In re Application of :
GOODMAN, Murray :
Application No.: 10/522,130 : DECISION ON
PCT No.: PCT/US03/22772 :
Int. Filing Date: 18 July 2003 : PETITION
Priority Date: 19 July 2002 :
Attorney Docket No.: SDUC1100-1 : UNDER 37 CFR 1.47(a)
For: DENDRIMERS AS MOLECULAR :
TRANSLOCATORS :
:

This is a decision on applicants' "Petition Under 37 C.F.R. §1.47(a)," filed in the United States Patent and Trademark Office (USPTO) on 17 January 2006.

BACKGROUND

On 18 July 2003, applicants filed international application PCT/US03/22772, which claimed a priority date of 19 July 2002. The thirty-month period for paying the basic national fee in the United States expired at midnight on 19 January 2005.

On 19 January 2005, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 17 August 2005, the Office mailed Notification of Missing Requirements (Form PCT/DO/EO/905) indicating that a declaration in compliance with 37 CFR 1.497(a)-(b) was required.

On 17 January 2006, applicants submitted a petition under 37 CFR 1.47(a), which was accompanied by, *inter alia*, the fee for a three month extension of time.

DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the non-signing applicant.

Items (1) and (3) have been satisfied. The balance of the \$200 petition fee will be charged to deposit account no. 50-0872, as authorized. Applicants list the last known addresses for the three non-signing inventors as:

Changhee Min, Kum-na-mu Apartment, 201-803 Doonsan-dong, Suh-ku Daejons, Korea
Byung Hyune Choi 963-4 Bangbae-dong, Seocho-ku, Korea 137-846 and
Hyun-Ho Chung, 10590 Gaylemon Ln, San Diego, CA 92130.

Item (2) has not been satisfied. Applicants have not furnished evidence of receipt of the complete copy of the application papers, including the declaration, by the non-signing inventors. The petition does not indicate first hand knowledge of the presentation, nor does it detail the presentation of the papers to the inventors. A statement from someone with firsthand knowledge of the presentation of a complete copy of the application papers, not just the declaration, to the inventors is required. Failure to execute a declaration in the absence of presentation with a complete copy of the application papers is not ordinarily sufficient to establish refusal to join. MPEP 409.03(d). Copies of returned mail receipts or other evidence supporting a contention that applicants were presented with a complete copy of the application papers and copies of the mailings to the inventors should be provided.

Item (4) has not been satisfied. The international application lists six inventors. The declaration executed by Murray Goodman lists three inventors. The declarations executed by Churl Min Seong and Guido Harms appear to list seven inventors as they list Changhee Min twice. The declarations fail to comply with 37 CFR 1.497 (a) as they fail to list the inventors on the international application, including corrections under PCT Rule 92bis, and any corrections made under 37 CFR 1.182 and 1.497(d). New declarations are required. Applicants should also furnish an explanation from Murray Goodman as to why he signed a declaration listing only three inventors.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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